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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,672	02/23/2004	Michael P. Whitman	11443/160	2683
26646 7590 04/02/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER WEEKS, GLORIA R				
ART UNIT 3721		PAPER NUMBER		
MAIL DATE 04/02/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/785,672

Applicant(s)

WHITMAN ET AL.

Examiner

GLORIA R. WEEKS

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 100-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 100-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. This action is in response to the amendment received on March 19, 2008

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 19, 2008 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 100-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grant et al. (USPN 5,609,285) in view of Osada (USPN 6,162,236).

In reference to claims 100-103, Grant et al. discloses a surgical device, comprising: a staple housing 60 defining a bore; a trocar shaft 202 disposed through the bore of the housing 60 and extends distally¹ relative to a clamping face 102, so as to be moveable relative to the housing 60 by operation of at least one driver 84 within the housing 60; and an anvil 100 attachable to

¹ **dis·tal** (dɪsˈtāl) *adj.* 1. Anatomically located far from a point of reference, such as an origin or a point of attachment. (American Heritage Dictionary)

the trocar shaft 202 and configured to be moveable relative to the housing 60 by movement of the trocar shaft (84; column 11 lines 1-35; column 14 lines 14-18), wherein the anvil 100 includes an anvil shaft 110, the anvil shaft 110 defining a trocar receiving slot, and the trocar shaft 202 including a trocar 206 configured to be insertable within the trocar receiving slot (figure 10); and the trocar receiving slot is defined in an anvil sleeve 101 having an axially-extending bore in communication with the trocar receiving slot, wherein the axially-extending bore has a wide portion into which the trocar 200 is insertable and a narrow portion which retains the trocar within the axially-extending bore.

Grant et al. does not disclose the portion of the trocar shaft that extends between the clamping face 102 and the anvil 100 to be flexible. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the trocar shaft of Grant to be flexible, since Osada suggests that such a modification allows a trocar to be easily passed through the trocar shaft.

5. Claims 104-106 are rejected under 35 U.S.C. 103(a) as being obvious over Grant et al. (USPN 5,609,285) in view of Osada (USPN 6,162,236) as applied to claim 100 above, and further in view of Whitman (USPN 6,491,201).

Regarding claims 104-106, the modified apparatus of Grant et al. discloses a surgical instrument having a driver, but does not disclose the driver as being rotatable via an operator controlled motor. Whitman teaches a surgical instrument having a flexible shaft (215) movable relative to a housing (155) by way of a rotatable driver (170) selectively rotated by at least one motor (165) via a controller (160). It would have been obvious to one having ordinary skill in

the art at the time of the invention to modify the surgical instrument of Grant et al. to include the motor rotatable driver of Whitman, as column 3 lines 17-31 of Whitman states that such a modification allows an operator to selectively alter the direction in which the driver shaft is rotated.

Response to Arguments

6. Applicant's arguments with respect to claims 100-106 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations related to the claimed invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GLORIA R. WEEKS whose telephone number is (571)272-4473. The examiner can normally be reached on M-F 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Other helpful telephone numbers are listed for applicant's benefit:

- Allowed Files & Publication (888) 786-0101
- Assignment Branch (800) 972-6382
- Certificates of Correction (703) 305-8309
- Fee Questions (571) 272-6400
- Inventor Assistance Center (800) PTO-9199
- Petitions/special Programs (571) 272-3282
- Information Help line 1-800-786-9199

/Gloria R. Weeks/
Examiner, Art Unit 3721

/Rinaldi I Rada/
Supervisory Patent Examiner,
Art Unit 3721

April 2, 2008